REMARKS

Claims 1-14 are pending in the application (the "Application").

Claims 1-14 have been rejected.

Claims 1 and 14 have been amended.

Claims 1-14 remain in the application.

Reconsideration of the claims is respectfully requested.

Drawings

The Examiner objected to the Drawings because there were no labels or text descriptions next to any of the numbered elements in any of Figures 1-4. Proposed amended drawings are being submitted herewith for which the approval of the Examiner is requested

Specification

The disclosure was objected to because of an informality. The specification has been amended to correct the identified typographical error. No new matter has been added as a result of this amendment.

The title of the invention was objected to as not descriptive. The Applicant gratefully acknowledges the Examiner's suggestion of a title and has so amended the specification.

35 U.S.C. § 102(b) Anticipation

In Section 4 of the June 5, 2003 Office Action, the Examiner rejected Claims 1-9 and 11-14 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,793,361 to *Kahn et al.* (hereafter "*Kahn*"). The Applicant respectfully traverses the Examiner's assertion that the Applicant's invention has been anticipated by the *Kahn* reference. The Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-9 and 11-14 in view of the Applicant's arguments.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131. *See*, *In re King*, 231 USPQ 126, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to amended independent Claim 1, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Kahn* to enable one of ordinary skill in the art to make and practice the claimed invention.

The Applicant respectfully disagrees with the Examiner's assertions regarding the subject matter disclosed in the *Kahn* reference. The Applicant respectfully submits that the *Kahn* reference

does not show each and every limitation of the Applicant's invention. The Applicant directs the Examiner's attention to amended Claim 1, which contains unique and novel limitations:

> 1. (Currently amended) A display system comprising a display device having
> window means for displaying information in at least two windows of said display device,
> parameter control means for controlling a parameter of a respective one of said windows in response to a user supplied parameter control command, and
> user operable window selection means for selecting a window to be controlled by said parameter control means, characterized in that
> the display system comprises at least two remote controls,
> the display system comprising association means for associating a respective remote control with a respective window,
> the window selection means being adapted to select the window in response to a parameter control command received from a remote control associated with the selected window, the parameter control command comprising window identification information.
> (Emphasis added).

The *Kahn* reference teaches a system that calculates the centroid of a light beam from a hand-held pointer and, from the centroid information, determines which screen is the target of the pointer. (*Kahn*, Column 7, Lines 34-38). Because the computer system of *Kahn* "knows" which application is running in each portion of the display system, the command from the pointer can be delivered to the intended application based upon the determination of the target screen. (*Kahn*, Column 7, Lines 64-67). Therefore, *Kahn* teaches a system that selects an application based upon where the pointer is aimed.

The Applicant respectfully submits that amended Claim 1 is not anticipated by the *Kahn* reference. Therefore, the Applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. § 102(b) has been overcome.

With respect to Claims 2-9 and 11-13, the Applicant notes that these claims depend directly or indirectly from amended Claim 1. As previously described, amended Claim 1 contains unique and novel claim limitations of the Applicant's invention. Therefore, Claims 2-9 and 11-13 also contain the same unique and novel claim limitations of amended Claim 1 and are therefore patentable over the *Kahn* reference.

With respect to independent Claim 14, the Applicant respectfully disagrees with the Examiner's assertions regarding the subject matter disclosed in the *Kahn* reference. The Applicant respectfully submits that the *Kahn* reference does not show each and every limitation of the Applicant's invention. The Applicant directs the Examiner's attention to amended Claim 14, which contains unique and novel limitations:

> 14. (Currently amended) A method of controlling a multi-window display system, comprising
>
> a step of user operably selecting a window, and
>
> a step of controlling a parameter of said selected window in response to a user supplied parameter control command, characterized in that the method further comprises
>
> a step of associating a respective one of at least two remote controls with a respective window, and
>
> a step of selecting the window in response to a parameter control command received from a remote control associated with the selected window, the parameter control command comprising window identification information. (Emphasis added).

For the same reasons given above with respect to amended Claim 1, the Applicant respectfully submits that amended Claim 14 is not anticipated by the *Kahn* reference. Therefore, the Applicant respectfully submits that the rejection of Claim 14 under 35 U.S.C. § 102(b) has been overcome.

The Applicant respectfully submits that Claims 1-9 and 11-14 are in condition for allowance. Allowance of amended Claims 1-9 and 11-14 is respectfully requested.

35 U.S.C. § 103(a) Obviousness

In Section 5 of the June 5, 2003 Office Action, the Examiner rejected Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,793,361 to *Kahn et al.* (hereafter "*Kahn*"). The Applicant respectfully traverses the Examiner's assertion that the Applicant's invention is obvious in view of the *Kahn* reference. The Applicant respectfully requests the Examiner to withdraw the rejection of Claim 10 in view of the Applicant's arguments.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

With respect to Claim 10, the Applicants note that this claim depends indirectly from amended Claim 1. As previously described, amended Claim 1 contains unique and novel claim limitations of the Applicants' invention not shown in the *Kahn* reference. Thus, Claim 10 also contains the same unique and novel claim limitations of amended Claim 1. The Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with

respect to Claim 10 of the Applicant's invention, and that the rejection of Claim 10 under 35 U.S.C. § 103(a) has thus been overcome.

The Applicant respectfully submits that Claim 10 is in condition for allowance. Allowance of Claim 10 is respectfully requested.

The Applicant's attorney has made the amendments and arguments set forth above in order to place this Application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments and arguments to properly frame the issues for appeal. In this Amendment, the Applicant makes no admission concerning any now moot rejection or objection, and affirmatively denies any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at ***wmunck@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Sept. 5, 2003

William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*